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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,756	04/13/2006	Hiroyoshi Kato	1691-0218PUS1	6847
2292 7590 02/02/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER GREEN, ANTHONY J				
ART UNIT		PAPER NUMBER		
1793				
NOTIFICATION DATE		DELIVERY MODE		
02/02/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Office Action Summary

**Application No.**

10/575,756

**Applicant(s)**

KATO ET AL.

**Examiner**

Anthony J. Green

**Art Unit**

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3, 4 and 6-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3, 4 and 6-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. This office action is in response to the reply submitted on 11 December 2008. Claims 16-19 have been added and accordingly claims 3-4 and 6-19 are currently pending in the application.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3-4 and 6-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Specification No. JP 2001-233661 A in view of Lin (US Patent No. 5,518,980 A) for the reasons set forth in the previous office action and which are herein incorporated by reference.

Applicant again argues that the instant claims are not obvious over the combination of references as they still fail to suggest the present invention achieving excellent setting properties, as shown in the enclosed Declaration, by using calcium hydroxide having an average particle diameter of 3  $\mu\text{m}$  or less. Such results are completely unexpected. Further applicant argues, as shown by the table and Figure present in the declaration, that the initial and final setting times drastically change when the average particle diameter of calcium hydroxide exceeds 3  $\mu\text{m}$ . The new evidence

includes data points generated with calcium hydroxide having an average particle diameter of 3.3  $\mu\text{m}$  as well as an average particle diameter of 2.7  $\mu\text{m}$  both of which are very close to the claimed threshold of 3  $\mu\text{m}$  and therefore the declaration clearly illustrates the criticality of the average particle diameter being 3  $\mu\text{m}$  or less. Thus, any hypothetical *prima facie* case of obviousness is moot.

It is the position of the examiner that the declaration is not commensurate in scope with the instant claims as applicant has not demonstrated that a particle size of 3 microns achieves superior setting times as compared to the use of a calcium hydroxide having a particle size of greater than 3 microns. Note that the declaration shows the setting times achieved when using calcium hydroxide particles having a particle size of 2.7, 2.5, 1.3 and .5 microns (which is below the claimed limitation of 3 microns or less) as compared with calcium hydroxide particles having a particle size of 3.3, 3.8, 6.5, 23.5 and 62.0 (which is above the claimed limitation of 3 microns or less) however applicant has not shown the results achieved when using calcium hydroxide particles having a size of 3 microns. That is, the closest particle size applicant shows which is below 3 or less is 2.7 and the closest above is 3.3. Accordingly it is the position of the examiner that since applicant has not adequately shown that unexpected results are achieved when using calcium hydroxide having a particle size of 3 microns (the upper limit of the particle size being claimed) as compared with one having a particle size of slightly greater than 3 microns, the declaration is not commensurate in scope with the instant claims. Further the limitation of "for shortening the initial and final setting times of said cement composition" is an intended use or a statement of ultimate

intended utility. It should be noted that: Ultimate utility does not make a composition patentable. That is, the future use of a composition adds little or no patentable weight to a composition claim when the composition is the same (In re Pearson 181 USPQ 641). Patentability does not depend upon intended use (Ex parte Wikdahl 10 USPQ2d 1546).

4. Claims 3-4 and 6-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikuchi et al (US Patent No. 4,650,523 A) in view of Lin (US Patent No. 5,518,980 A) for the reasons set forth in the previous office action and which are herein incorporated by reference.

Applicant again argues that the instant claims are not obvious over the combination of references as they still fail to suggest the present invention achieving excellent setting properties, as shown in the enclosed Declaration, by using calcium hydroxide having an average particle diameter of 3  $\mu\text{m}$  or less. Such results are completely unexpected. Further applicant argues, as shown by the table and Figure present in the declaration, that the initial and final setting times drastically change when the average particle diameter of calcium hydroxide exceeds 3  $\mu\text{m}$ . The new evidence includes data points generated with calcium hydroxide having an average particle diameter of 3.3  $\mu\text{m}$  as well as an average particle diameter of 2.7  $\mu\text{m}$  both of which are very close to the claimed threshold of 3  $\mu\text{m}$  and therefore the declaration clearly illustrates the criticality of the average particle diameter being 3  $\mu\text{m}$  or less. Thus, any hypothetical *prima facie* case of obviousness is moot.

It is the position of the examiner that the declaration is not commensurate in scope with the instant claims as applicant has not demonstrated that a particle size of 3 microns achieves superior setting times as compared to the use of a calcium hydroxide having a particle size of greater than 3 microns. Note that the declaration shows the setting times achieved when using calcium hydroxide particles having a particle size of 2.7, 2.5, 1.3 and .5 microns (which is below the claimed limitation of 3 microns or less) as compared with calcium hydroxide particles having a particle size of 3.3, 3.8, 6.5, 23.5 and 62.0 (which is above the claimed limitation of 3 microns or less) however applicant has not shown the results achieved when using calcium hydroxide particles having a size of 3 microns. That is, the closest particle size applicant shows which is below 3 or less is 2.7 and the closest above is 3.3. Accordingly it is the position of the examiner that since applicant has not adequately shown that unexpected results are achieved when using calcium hydroxide having a particle size of 3 microns (the upper limit of the particle size being claimed) as compared with one having a particle size of slightly greater than 3 microns, the declaration is not commensurate in scope with the instant claims. Further the limitation of "for shortening the initial and final setting times of said cement composition" is an intended use or a statement of ultimate intended utility. It should be noted that: Ultimate utility does not make a composition patentable. That is, the future use of a composition adds little or no patentable weight to a composition claim when the composition is the same (In re Pearson 181 USPQ 641). Patentability does not depend upon intended use (Ex parte Wikdahl 10 USPQ2d 1546).

5. Claims 3-4 and 6-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simeonov et al (US Patent No. 4,205,998 A) in view of Lin (US Patent No. 5,518,980 A) for the reasons set forth in the previous office action and which are herein incorporated by reference.

Applicant again argues that the instant claims are not obvious over the combination of references as they still fail to suggest the present invention achieving excellent setting properties, as shown in the enclosed Declaration, by using calcium hydroxide having an average particle diameter of 3  $\mu\text{m}$  or less. Such results are completely unexpected. Further applicant argues, as shown by the table and Figure present in the declaration, that the initial and final setting times drastically change when the average particle diameter of calcium hydroxide exceeds 3  $\mu\text{m}$ . The new evidence includes data points generated with calcium hydroxide having an average particle diameter of 3.3  $\mu\text{m}$  as well as an average particle diameter of 2.7  $\mu\text{m}$  both of which are very close to the claimed threshold of 3  $\mu\text{m}$  and therefore the declaration clearly illustrates the criticality of the average particle diameter being 3  $\mu\text{m}$  or less. Thus, any hypothetical *prima facie* case of obviousness is moot.

It is the position of the examiner that the declaration is not commensurate in scope with the instant claims as applicant has not demonstrated that a particle size of 3 microns achieves superior setting times as compared to the use of a calcium hydroxide having a particle size of greater than 3 microns. Note that the declaration shows the setting times achieved when using calcium hydroxide particles having a particle size of 2.7, 2.5, 1.3 and .5 microns (which is below the claimed limitation of 3 microns or less)

as compared with calcium hydroxide particles having a particle size of 3.3, 3.8, 6.5, 23.5 and 62.0 (which is above the claimed limitation of 3 microns or less) however applicant has not shown the results achieved when using calcium hydroxide particles having a size of 3 microns. That is, the closest particle size applicant shows which is below 3 or less is 2.7 and the closest above is 3.3. Accordingly it is the position of the examiner that since applicant has not adequately shown that unexpected results are achieved when using calcium hydroxide having a particle size of 3 microns (the upper limit of the particle size being claimed) as compared with one having a particle size of slightly greater than 3 microns, the declaration is not commensurate in scope with the instant claims. Further the limitation of "for shortening the initial and final setting times of said cement composition" is an intended use or a statement of ultimate intended utility. It should be noted that: Ultimate utility does not make a composition patentable. That is, the future use of a composition adds little or no patentable weight to a composition claim when the composition is the same (In re Pearson 181 USPQ 641). Patentability does not depend upon intended use (Ex parte Wikdahl 10 USPQ2d 1546).

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anthony J. Green/

Primary Examiner  
Art Unit 1793

ajg  
January 28, 2009